

USSN: 10/567,974  
Group Art Unit: 1714  
Docket No.: 160P1582USWO

### Remarks

Claims 1-33 are pending in the application. No amendments are presented herein. Applicant requests reconsideration.

### Rejection under 35 U.S.C. § 103

Claims 1-33 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Tomko *et al.* (U.S. Patent No 6,166,127, “the ‘127 patent”) in view of Floyd *et al.* (U.S. Patent No.5,422,392, “the “392 patent”). This rejection is respectfully traversed.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not establish a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness, see MPEP § 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one skilled in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations, see MPEP § 2142.

The Office Action concedes that Tomko fails to disclose the VOC levels recited in the claims. Applicant notes that, although Tomko recites having pendant ionizable groups incorporated into a prepolymer, the patent fails specifically to disclose sulfonated polyols. The only diol having a pendant ionizable group recited in Tomko appears to be dimethylolpropionic acid (see column 6, line 6 and in the examples). If a sulfonated polyol is disclosed in Tomko the Examiner is requested to point out the location within the document. Accordingly, the combination of cited documents fails to include all the limitations of claim 1.

Floyd discloses using an oligomeric modified binder of polymerized ethylenic monomers (see column 3, lines 39-40) and requires the use of a surfactant and high shear or ultrasound processing to prepare a dispersion (see column 3, lines 55-56, column 6, lines 35-38 and column 9 line 57-58). Tomko does not disclose or suggest using a high shear process, nor does Tomko disclose or suggest stabilizing the urethane with surfactant.

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There is no teaching or suggestion in either Tomko or Floyd to modify or to combine their disclosures to obtain applicants' claims. A person skilled in the art of preparing coating compositions would not be inclined to combine the disclosure of Floyd, *e.g.*, using an oligomeric modified binder of polymerized ethylenic monomers and high sheer processing with Tomko's interpenetrating networks to prepare the claimed polyurethane/vinyl monomer composition.

Accordingly, it is respectfully requested that the rejection of the claims under 35 U.S.C. § 103 be withdrawn.

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## CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 455-2564 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0549.

Respectfully submitted on behalf of  
T. HOWARD KILILEA,

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By   
William F. Prout  
Registration No: 33,995  
612-455-2564 (telephone)  
612-331-7401 (facsimile)  
Customer No. 23322

IPLM Group, P.A.  
P.O. Box 18455  
Minneapolis, MN 55418